

### **REMARKS**

The Non-Final Office Action has been carefully reviewed and the following remarks are made in light of the Action.

Claim 15 has been amended to re-introduce the missing “and” and suggested by the Examiner. Claim 18 has been amended by adopting the Examiner’s suggestion.

No new matter has been added by way of these amendments. Entry and consideration of the foregoing amendments is respectfully requested.

### **RESPONSE**

#### **I. Objection to Claim 15**

Applicants respectfully submit that the word “and” between parts (a) and (b) was missed due to a typographical error in previously filed Amendment/Response. The “and” has been re-introduced.

Examiner is requested to remove the objection to claim 15 in light of these amendments.

#### **II. Claim Rejections – 35 USC § 112, First Paragraph – Written Description**

Claims 2-4, 6-19, 30 and 31 remain rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the written description requirement. More specifically, the Office Action alleges that the specification does not identify which conserved germplasm is associated with the claimed traits.

Applicants respectfully submit that under 35 U.S.C. §112, there is no burden for the Applicants to show which portion of the ‘French’ type germplasm is contributing to the claimed

characteristics. Instead, the Applicants only have the burden to show how to make and use the claimed invention. As stated in MPEP 2138.05 "Reduction to Practice", section IV, "[an] inventor need not understand precisely why his invention works in order to achieve an actual reduction to practice" (*Parker v. Frilette*, 462 F.2d 544, 547, 174 USPQ 321, 324 (CCPA 1972)). Therefore, Applicants can still teach how to make and use the claimed invention without knowing which portion of the 'French' type germplasm is contributing to the claimed characteristics.

In addition, Applicants are not claiming ANY alfalfa plants with 'French' types germplasm. Instead, Applicants are claiming alfalfa plants with 'French' type germplasm, wherein the plants have the claimed characteristics.

Applicants respectfully submit that the present application provides much detail regarding how to produce alfalfa varieties having claimed phenotypes with 'French' types germplasm. Therefore, by following the methods described in the present application, e.g., the procedure described in Example 3, one skilled in the art will surely be able to identify alfalfa varieties having the claimed characteristics, without knowing exactly which portion of the 'French' types germplasm is contributing to the claimed characteristics.

Applicants also respectfully submit that a representative number of different species of plants with the claimed characteristics has been shown in the present application, such as 'CW 75046', 'CW 83021', 'CW 85029', and 'CW 95026'. In addition, as Applicants have repeatedly asserted during the course of prosecuting the present application, anyone skilled in the art of alfalfa variety development can follow the procedures described in the as-filed specification to develop additional varieties which fall within the limitations of the claimed alfalfa varieties with 8% or greater faster recovery after spring green-up or after harvest compared to an adapted check

variety grown under the same field growing conditions, and 15% or greater more erect stems at late (i.e., 75% bloom) when compared to the specific adapted check alfalfa varieties as set forth in the claims. Alternatively, one skilled in the art can use any of Applicant's inventive, disclosed and deposited alfalfa varieties to develop additional alfalfa varieties which meet the claimed limitations. The Declaration by Dr. Johnson and the accompanying Exhibit I ("the Johnson Declaration"), which was submitted on December 7, 2009 in the present application clearly demonstrates that Applicants have done exactly this (i.e., developed additional *Medicago sativa* alfalfa varieties with the claimed traits by using the exemplary, deposited varieties as a source of genetic material in the breeding regime leading to such additional varieties). The Johnson Declaration provides evidence that Applicants have used one or more of each of the four exemplified varieties to develop at least three additional alfalfa varieties which meet the limitations of the alfalfa varieties claimed in independent claim 1. Thus, anyone skilled in the art of plant breeding can utilize one or more of the exemplified, deposited alfalfa varieties developed by the inventors to produce additional alfalfa varieties with the new and inventive traits now claimed.

In summary, the specification as-filed teaches detailed methods of making and using the present invention, including all necessary materials to use, and all procedures and standards to follow. The specification also shows a representative number of different species of plants with the claimed characteristics. Therefore, the specification is written in a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed. The Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. §112 on claims 2-4, 6-19, 30 and 31.

III. Claim Rejections – 35 USC § 102(b)

Claim 18 is rejected under 35 USC § 102(b) as allegedly being anticipated by Barnes et al.

Applicants have amended claim 18 as suggested by the Examiner. Thus, the Examiner is respectfully requested to withdraw this rejection.

IV. Claim Rejections – Double Patenting

Claims 6-19 and 31 are rejected by the Examiner on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of U.S. Patent No. 7,288,698.

Claims 2-4, 15-19 and 31 are rejected by the Examiner on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of U.S. Patent No. 7,288,697.

Claims 2-4, 6-19 and 30-31 are rejected by the Examiner on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of each of U.S. Patent Nos. 7,288,697 and 7,288,698.

Applicants enclose herewith a terminal disclaimer in the form PTO/SB/26 with the appropriate fee. The Examiner is respectfully requested to withdraw this rejection in light of the terminal disclaimer.

### CONCLUSION

Applicants look forward to allowance of the pending claims or appealing this to the Board of Patent Appeals and Interferences for their consideration of Applicants' responses to each of the rejections, as discussed above. The Examiner is invited to contact the undersigned if necessary to advance prosecution of this application.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 CFR §1.136(a)(3).

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